

Remarks

The Office Action of November 1, 2004 has been reviewed and its contents carefully noted. Reconsideration of this case is earnestly requested. Claims 1-18 are pending in the application.

In view of the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

The Examiner's attention is drawn to the fact that, submitted herewith is Applicant's Declaration under 37 C.F.R. § 1.132, attesting to facts showing that the claimed invention is neither anticipated by nor obvious over the prior art of record.

Objection to the Drawing

The Examiner objected to the drawing, stating that Figures 3A and 3B should be designated by a legend such as –Prior Art– because only that which is old is illustrated. Applicant respectfully disagrees with the objection.

The Examiner asserts that Applicant's Figures 3A and 3B are prior art. However, the Examiner has not provided any evidence to show that the subject matter of Applicant's Figures 3A and 3B was published prior to the filing date of the application. Therefore, there is no evidence of record to support the Examiner's assertion that Applicant's Figures 3A and 3B constitute prior art.

Applicant maintains that Figures 3A and 3B are not prior art. Rather, Figures 3A and 3B illustrate certain potential problems that are solved by Applicant's invention. It is respectfully submitted that the objection is thus overcome. Reconsideration and withdrawal of the objection to the drawing are therefore respectfully requested.

Rejection under 35 U.S.C. § 102

Claims 1-3, 7-9 and 13-18 were rejected under 35 USC 102(e) as being anticipated by Gordon (US 6,665,898). Applicant respectfully disagrees with the rejection.

According to MPEP 2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant's claims 1, 7 and 13 each recite an apparatus for adjusting a mattress, said apparatus having, *inter alia*, a **substantially convex cross-sectional shape**, and a **material and constitution for maintaining the convex shape** under the weight of the mattress and a person.

Gordon does not disclose an apparatus having a substantially convex cross-sectional shape, and a material and constitution for maintaining the convex shape under the weight of the mattress and a person. Indeed, the Examiner has not identified where in Gordon an apparatus having a substantially convex cross-sectional shape is alleged to be disclosed. Applicant notes that Figure 3B of Gordon shows a 2-dimensional ellipse, and it is presumed that this is the basis for the Examiner's conclusion that Gordon discloses a convex cross-sectional shape. Applicant respectfully disagrees.

Attached hereto is the Declaration of Jon D. Pearson under 37 C.F.R. § 1.132, attesting to facts showing that Gordon does not disclose, teach or suggest an apparatus having a substantially convex cross-sectional shape, and a material and constitution for maintaining the convex shape under the weight of the mattress and a person, as recited in Applicant's claims. More particularly, the Declarant testifies that the apparatus of Gordon does not have a substantially convex cross-sectional shape, and simply cannot maintain a substantially convex cross-sectional shape, particularly under the weight of a mattress and a person.

Gordon's patent does not disclose, teach or suggest an apparatus having a substantially convex cross-sectional shape. Further, Gordon does not disclose, teach or suggest a material and constitution for maintaining the convex shape, especially under the weight and pressure of the mattress and a person. For example, Gordon's device is designed to be "placed under the center region of a sagging or new mattress" and "may include between two and four lobes extending outwardly at ninety degrees from one another." (Gordon Abstract and column 1, lines 41-42). Applicant's invention, on the other hand, "controls the firmness, support, and sag of the majority of a single sleeping area" (specification at page 2, lines 25-26, emphasis added), rather than merely the center region (Gordon Figure 3B and column 3, lines 1-4). Indeed, Gordon expressly states that "the present invention seeks to correct this mattress sag in the center region 20 of the sleeping surface." (Gordon column 2, lines 41-43 and column 3, lines 1-4).

Indeed, there is absolutely no disclosure whatsoever anywhere in Gordon of an apparatus having the convex cross-sectional shape recited in Applicant's claims. Furthermore, there is absolutely no disclosure whatsoever anywhere in Gordon of suitable materials and/or methods for maintaining a convex cross-sectional shape, particularly under the weight and pressure of the mattress and a person. Therefore, Gordon does not disclose each and every limitation of Applicant's independent claims 1, 7 and 13. It is respectfully submitted that the rejection is thus overcome. Reconsideration and withdrawal of the rejection of independent claims 1, 7 and 13 as being anticipated by Gordon are therefore respectfully requested.

Dependent claims 2-3, 8-9 and 14-18, being dependent upon and further limiting independent claims 1, 7 and 13, respectively, should be allowable for that reason, as well as for the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 1-3, 7-9 and 13-18 as being anticipated by Gordon are therefore respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 4, 5, 10 and 11 were rejected under 35 USC 103(a) as being obvious over Gordon (US 6,665,898) in view of Reeder *et al.* (US 6,460,209). More particularly, the Examiner maintains that Gordon discloses all of the features of the claimed invention, with the exception of baffles and a plurality of hollow chambers, wherein shorter hollow chambers are located towards the edges and longer hollow chambers are located in the center areas.

Applicant respectfully disagrees, and maintains that the claims are patentable over Gordon and Reeder *et al.*, individually and in combination, for the reasons given above with respect to the section 102 rejection of claims 1-3, 7-9 and 13-18. The arguments above as to the novelty of Applicant's independent claims 1, 7 and 13 are thus repeated here by reference, rather than repeating them *verbatim*.

According to MPEP 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure, as such would be indicative of impermissible hindsight.

Thus, to establish a *prima facie* case of obviousness, the Examiner is required to cite a combination of prior art that not only teaches each and every element of the rejected claims, but also is required to cite substantial evidence to support the conclusion that one of ordinary skill in the art would be motivated to combine or modify the references as suggested, as well as substantial evidence that one of ordinary skill in the art would have a reasonable expectation of success in making the cited combination or modification.

It is respectfully submitted that the Examiner has not met the initial burden of making a proper *prima facie* showing of obviousness. More particularly, in making the obviousness rejection, the Examiner asserts that one of ordinary skill in the art would be motivated to modify Gordon and would have a reasonable expectation of success in making Applicant's invention, however, the Examiner cites absolutely no authority in support of such factual assertions. If the Examiner's assertions are intended to indicate that the obviousness rejection is based on common knowledge in the art or "well known" prior art under MPEP 2144.03, then Applicant hereby traverses the Examiner's assertions.

As noted above in regard to the section 102 rejection of claims 1-3, 7-9 and 13-18, Gordon does not disclose, teach or suggest an apparatus having a substantially convex cross-sectional shape, and a material and constitution for maintaining the convex shape under the weight of the mattress and a person. Indeed, Gordon's disclosure is wholly devoid of any teaching regarding suitable materials and/or methods for maintaining a convex cross-sectional shape, particularly under the weight and pressure of the mattress and a person. See Declaration of Jon D. Pearson under 37 C.F.R. § 1.132. Further, Reeder *et al.* does not cure the deficiencies of Gordon, as Reeder also does not disclose, teach or suggest an apparatus having a substantially convex cross-sectional shape, and a material and constitution for maintaining the convex shape under the weight of the mattress and a person.

Therefore, the combination of Gordon and Reeder *et al.* does not teach or suggest each and every limitation of Applicant's independent claims 1 and 7. It is respectfully submitted that the rejection is thus overcome. Dependent claims 4, 5, 10 and 11, being dependent upon and further limiting independent claims 1 and 7, should be allowable for that reason, as well as for the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 4, 5, 10 and 11 as being obvious over Gordon in view of Reeder *et al.* are therefore respectfully requested.

Claims 6 and 12 were rejected under 35 USC 103(a) as being obvious over Gordon (US 6,665,898) in view of Pepe (US 5,787,531). More particularly, the Examiner maintains that Gordon discloses all of the features of the claimed invention, with the exception of separate inflatable chambers.

Applicant respectfully disagrees, and maintains that the claims are patentable over Gordon and Pepe, individually and in combination, for the reasons given above with respect to the section 102 rejection of claims 1-3, 7-9 and 13-18. The arguments above as to the novelty of claims 1, 7 and 13 and the non-obviousness of claims 1 and 7 are thus repeated here by reference, rather than repeating them *verbatim*.

As noted above in regard to the section 102 rejection of claims 1-3, 7-9 and 13-18, and the obviousness rejection of claims 4, 5, 10 and 11, Gordon does not disclose, teach or suggest an apparatus having a substantially convex cross-sectional shape, and a material and constitution for maintaining the convex shape under the weight of the mattress and a person. Indeed, Gordon's disclosure is wholly devoid of any teaching regarding suitable materials and/or methods for maintaining a convex cross-sectional shape, particularly under the weight and pressure of the mattress and a person. See Declaration of Jon D. Pearson under 37 C.F.R. § 1.132. Further, Pepe does not cure the deficiencies of Gordon, as Pepe also does not disclose, teach or suggest an apparatus having a substantially convex cross-sectional shape, and a material and constitution for maintaining the convex shape under the weight of the mattress and a person. Although Pepe discloses chambers of varying diameters, with larger cells being in the middle, the design is not convex; it only becomes more narrow on the top and bottom, not the sides. Thus, Pepe does not disclose, teach or suggest suitable means and/or methods for maintaining a convex cross-sectional shape, particularly under the weight and pressure of the mattress and a person.

Therefore, the combination of Gordon and Pepe does not teach or suggest each and every limitation of Applicant's independent claims 1 and 7. It is respectfully submitted that the rejection is thus overcome. Dependent claims 6 and 12, being dependent upon and further limiting independent claims 1 and 7, should be allowable for that reason, as well as for the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 6 and 12 as being obvious over Gordon in view of Pepe are therefore respectfully requested.

Conclusion

Based upon the above remarks and the papers of record, Applicant believes that the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1-18 and a prompt Notice of Allowance thereon.

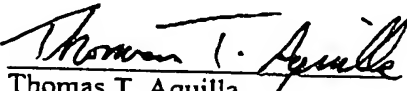
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account No. 50-0289.

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Please direct any questions or comments to Thomas T. Aquilla at (607) 256-7330.

Respectfully submitted,
WALL MARJMA & BILINSKI

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